

FEB 05 2008

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END5007USNPRemarksStatus of Claims

Claims 1-13 and 16-20 were rejected. Claims 1, 16, and 17 have been amended. New claims 21 and 22 have been added. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§102 Rejections

In the Office Action dated 11/05/2007, claim 16 was rejected under 35 U.S.C. §102(b) as being unpatentable over Burbank (U.S. 5,526,822). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Burbank fails to teach or suggest all of the limitations recited in amended independent claim 16, particularly in the arrangement required by the claim. For instance, amended independent claim 16 recites a "sample tube being releasably supported on the biopsy device." Burbank fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended claim 16. Indeed, the Office has explicitly admitted that Burbank fails to disclose a "sample tube being releasably supported on the biopsy device." (See Office Action dated 11/05/2007 at page 7, paragraph "23"). Burbank also fails to teach or suggest limitations noted below with respect to the §103 rejection of claim 16. Accordingly, Burbank fails to anticipate amended claim 16 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

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END5007USNP§103 Rejections

Claims 1-13 and 16-20 were rejected under 35 U.S.C. §103(a) as being obvious over Burbank in view of Banik (U.S. 6,053,877). Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, all of the limitations of a claim must be considered. For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of present claims 1-13 or 16-20 obvious.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, Applicant notes that independent claim 1 recites a “plurality of holes are formed transversely through the sidewall of the cutter for providing fluid communication from a region exterior to the sidewall of the cutter to the interior of the cutter,” where the cutter is “advancable within the biopsy needle.” These limitations, among others recited in claim 1, are neither taught nor suggested by the combined art of record. Applicant appreciates the Office’s explicit acknowledgement that Burbank fails to disclose a cutter that has a plurality of holes spaced from the distal end of the cutter. (See Office Action dated 11/05/2007 at p. 3, paragraph “8”). However, rather than actually finding any prior art teaching of a plurality of holes in a cutter as recited in claim 1, the Office simply stated that it would have been obvious to provide such holes. Applicant submits that this clearly violates the mandate of MPEP 2143.03 that requires the Office to consider every limitation of a claim. In other words, the Office may not simply refrain from finding a prior art teaching of a claim limitation when making an obviousness rejection as the Office has done here. Ultimately, neither Burbank nor Banik, even in combination, disclose a “plurality of holes are formed transversely through the sidewall of the cutter for providing fluid communication from a region exterior to the sidewall of the cutter to the interior of the cutter,” where the cutter is “advancable within the biopsy needle” as recited in amended claim 1. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Independent claim 16 recites “a sample tube advancement assembly, wherein the sample tube advancement assembly is operable to advance the sample tube distally within the cutter to store a tissue sample within the sample tube after the cutter has been advanced within the needle

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to sever the tissue sample.” These limitations, among others recited in claim 16, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claim 16 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 16 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Independent claim 17 recites “at least a portion of the act of advancing the hollow sample tube is performed after the cutter has reached the distalmost position and after the cutter has encapsulated the severed tissue sample.” These limitations, among others recited in claim 17, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claim 17 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 17 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims that are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

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Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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